

**REMARKS**

This Amendment and Response is intended to fully respond to the Office Action mailed June 16, 2004. In that Office Action, claims 1-41 were examined, and all were rejected. More specifically, claims 1-41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent Number 6,199,196 issued to Madany et al., (hereinafter “Madany”).

Reexamination and reconsideration are respectfully requested in light of these remarks. Claims 1-41 are pending in the present application.

**Claim Rejections - 35 U.S.C. § 103**

Claims 1-41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent No. 6,199,196 issued to Madany et al., (hereinafter “Madany”).

Applicant respectfully traverses the section 103 rejections. The Examiner has failed to substantiate a prima facie case of obviousness because one or more of the requirements of a prima facie case is absent. Indeed, such a prima facie case can only be met when **all** of the following requirements are met: (1) there must be some suggestion or motivation in the references themselves (or in the knowledge available to those skilled in the art) to combine the references; (2) there must be a reasonable expectation of success; and (3) the combined references must teach or suggest all the claim limitations. See MPEP §§ 706.02(j) and 2143. In this case, Madany does not describe all of the claim limitations, e.g., generating a customized library including one or more client-needed types. Indeed, Madany teaches away from the present invention as described below.

The present invention includes a customized library management method and system for generating a customized library needed for execution of an application in a client system. In response to an identification of a given application, such as a request from the client system or an internal instruction of the server, the server determines the appropriate types to include in a library to be sent to the client based on certain parameters. The parameters may include, for example, the types referenced by the application, the types already loaded on the client system, and a device profile describing characteristics of the client system. The customized library includes types that are required by the application and that are not yet loaded on the client. The

requested application and the customized library are separately composed for the client to execute the application. The customized library includes types referenced by the application, but not loaded on the client.

In the present Office Action, the Examiner has cited Madany as disclosing a computer program product for generating an output file for execution of a program that identifies components stored on a client, identifies needed components, and creates a package of needed components. See col. 7, lines 10-49; col. 7, lines 60 – col. 8, line 16; col. 8, lines 56-67; col. 6, lines 1 – col. 7, line 3. The Examiner has also cited Madany as disclosing, “generating a customized library (creates a list/ output file/ package) including one or more client-needed types (required or needed component/ dependent component) (col. 7, lines 10-49; col. 7, lines 60 – col. 8, line 16; col. 8, lines 56-67; col. 6, lines 1 – col. 7, line 3).” Applicants respectfully disagree with this assertion. A prior art reference must be considered in its entirety, i.e. as a whole, including portions that would lead away from the claimed invention. See *W.L. Gore & Associates, Inc. v. Garlock, Inc.* 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983) and MPEP § 2141.02. Madany does not create a customized library of application referenced types not loaded on the client (client-needed types), but rather creates, “a packaged file (i.e., the output file mentioned above) containing *all* necessary components for program execution” (col. 8, lines 58-60) (*Emphasis added*). This is an important distinction as the “package” or output file described in Madany includes the components used in the application program and the components referenced by the application program, which is an entirely different output than the customized library in the amended claims of the present invention that includes types referenced by the application program but not already loaded on the client.

Madany also describes a method where the list created by the linkage editor starts with the program to be executed. Col. 7, lines 13-16. As described in Madany, the first component placed in the list is the main method (application program). Col. 9, lines 17-49. The customized library in the present contains types referenced by the application program and sends the library separate from the application.

The distinction between Madany and the present invention may be best shown by comparing FIG. 2 and FIG. 8, in the present application, to the method shown in FIG. 5 of

Madany. The present invention clearly shows that the customized library is separate from the components or types within the application, while Madany only describes sending a single output file. Thus, Madany teaches away from generating a customized library separate from the application, but describes generating a single output file containing all components both referenced by the application and part of the application. Madany requires the integration of the application components and application-referenced components that come from different publishers – an integration problem. In addition, Madany forces the client to disassemble the package if the client desires to separate the application components from the application-referenced components.

The Applicants respectfully disagree with the Examiner's suggestion in the office action that it would be obvious to one of ordinary skill in the art that, "the created list/ package is initially empty before the necessary components are added to the list as disclosed in Madany." First, the necessary components in Madany include components both referenced by the application and components that are a part of the application. Col. 7, lines 10-49; col. 7, lines 60 – col. 8, line 16; col. 8, lines 56-67; col. 6, lines 1 – col. 7, line 3. Thus, necessary components described in Madany are different than client-needed types in the present invention. In addition, as the method described in Madany shows, the main method or the program components are first placed in the output file before any application-referenced components are put into the output file. Col. 7, lines 10-49. Thus, the package cannot be empty before client-needed types, which are application-referenced types not loaded on the client, are added to the output file.

In light of the amended claims and for the reasons given above, Applicants respectfully request the withdrawal of the obviousness rejection of claim 1. Applicants also respectfully request the withdrawal of the obviousness rejections of claim 2 through claim 22 that depend from claim 1. As the Examiner admits, claim 23 makes reference to a method that corresponds to the computer program product of claim 1, and claims 24-33 make reference to a system that corresponds to the computer program product of claims 1-22. Therefore, in light of the amended claims and for the reasons stated above, Applicants respectfully request the withdrawal of the obviousness rejections of claims 23 through 33.

The Examiner rejects claim 34 under the same reasoning as claim 1. Examiner states that, “Madany teaches a computer product encoding a computer program for executing on a computer system a computer process for creating a customized library (output file / package) comprising: accessing a class library store (location of stored class file); identifying one or more needed classes (necessary classes/ components of the classes); creating an empty library (creates a list); extracting the one or more needed classes (needed components) from the class library store; and adding the one or more needed classes (needed components) to the empty library (list) to generate the customized library (col. 7, lines 10-49; col.7, lines 60 – col. 8, line 16; col. 8, lines 56-67; col. 6, lines 1 – col. 7, line 3).” Again, Examiner also states that it would be obvious to one skilled in the art that the created list/ package is initially empty before necessary components are added to the list.

For the same reasons as stated with claim 1, the Applicants respectfully disagree with the Examiner. The output file or package in Madany includes classes within the application and application-referenced classes. In addition, “needed components” within Madany refers to both classes within the application and application-referenced classes (col. 7, lines 10-49; col.7, lines 60 – col. 8, line 16; col. 8, lines 56-67; col. 6, lines 1 – col. 7, line 3) as opposed to application-referenced classes as described in the present invention. Madany does not teach adding the one or more needed classes, which are only application-referenced classes, to the empty library list to generate a customized library, which includes only application-referenced classes that are not loaded on the client. Therefore, Madany cannot render the present invention obvious and actually teaches away from the present invention.

In light of the amended claims and for the reasons given above, Applicants respectfully request the withdrawal of the obviousness rejection of claim 34, and thus, the obviousness rejections of claim 35 through claim 40 that depend from claim 34. Claim 41 makes reference to a method that corresponds to the computer program product of claim 34. Therefore, in light of the amended claims and for the reasons stated above, Applicants respectfully request the withdrawal of the obviousness rejection of claim 41.

Given that the Madany reference does not teach or suggest all the claim limitations of the amended claims, all claims are believed to be allowable over the prior art. That is, because

Madany does not disclose generating a customized library, which includes application-referenced types not already loaded on the client, claims 1, 23, 24, 26, 34, and 41 are not obvious in light of Madany. Similarly, all claims depending from those claims are also believed to be allowable and reconsideration of the outstanding rejections in light of these amendments and remarks is respectfully requested.

### **Conclusion**

As originally filed, the present application included 41 claims, 6 of which were independent. As amended the present application includes 41 claims 6 of which are independent. It is believed that no further fees are due with this Response. However, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment with respect to this patent application to deposit account number 13-2725.

In view of the above amendments and remarks, Applicant respectfully requests a Notice of Allowance. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

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9/9/2004



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